

UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE COMMISSIONER OF PATENTS AND TRADEMARKS

MAY 27 1999

In re

)
) Decision on
) Petition for Review
) Under 37 C.F.R. § 10.2(c)
)

MEMORANDUM AND ORDER

(“Petitioner”) seeks review of two decisions of the Office of Enrollment and Discipline (“OED”), denying both his request for reinstatement as a registered Patent Attorney and his request for a higher score on the August 27, 1997, Examination to Practice in Patent Cases Before the U.S. Patent and Trademark Office (“1997 examination”). The petition is denied.

Background

The Petitioner became registered to practice before the U.S. Patent and Trademark Office (“PTO”) in 1978. Sometime after his registration, the Petitioner’s business address changed. His address of record with the OED, however, was not updated to reflect that change. The Petitioner does not affirmatively state that he in fact sent his change of address to the OED. Instead, he merely states that he later “learned the OED had not updated its records of Petitioner’s business address” and that “[n]either OED or [sic] Petitioner is unable [sic] to explain why the OED files were incorrect.” The OED subsequently sent the Petitioner a survey at his address of record, inquiring whether he wished to remain on the Register of Patent Attorneys and Agents (“Register”). When the OED did not receive a reply, it removed the Petitioner’s name from the Register. See

In 1994, The Petitioner discovered that he had been removed from the Register. He requested reinstatement and submitted a showing pursuant to a notice in the Official Gazette, see 1064 O.G. 12 (Mar. 11, 1986). In a September 8, 1994, letter the OED denied the Petitioner's request, advising the Petitioner that it had concluded from a review of the Petitioner's showing that it "does not provide a basis to reinstate" him. The OED also informed the Petitioner that he could take the registration examination if he wished to become registered again. The Petitioner apparently did not receive that letter. In a letter dated January 6, 1995, the Petitioner inquired about the status of his reinstatement request. The Petitioner also informed the OED that, because of his "extensive experience in intellectual property practice," he had "no hesitancy" about taking the registration examination again. On January 26, 1995, the OED re-sent a copy of its September 8, 1994, letter to the Petitioner.

On March 3, 1995, the Petitioner wrote the OED, again stating his willingness to take the registration examination. The Petitioner also stated that he had not received an application for taking the registration examination in time for the May 1995 examination, and he requested application materials for the next scheduled examination. The Petitioner took the 1997 examination, but failed to obtain a passing grade in the morning section of that examination. The Petitioner then requested a regrade of questions 10, 13, 14, 23, 28, 34, 35, 48, and 49 of the morning section of the 1997 examination. The OED denied his regrade request for all questions, except question 10. With respect to question 10, the OED raised the Petitioner's score by two points, but advised him that his score still fell short of the minimum score necessary to pass the morning section of the 1997 examination.

Petitioner now seeks review pursuant to 37 C.F.R. § 10.2(c) of both the OED's decision denying his request for reinstatement based on his 1994 showing, and the OED's denial of his request for regrade of questions 28, 34, and 49 of the morning section of the 1997 examination.

Opinion

I. The Petitioner's Reinstatement Request

The Petitioner alleges that the OED abused its discretion when it removed him from the Register without disclosing a standard of review of his reinstatement request. He has failed, however, to raise those contentions in a timely manner. The Petitioner seeks review under 37 C.F.R. § 10.2(c) of OED's denial of his reinstatement request. Section 10.2(c) expressly requires that the petition be filed within 30 days of the OED's decision. See 37 C.F.R. § 10.2(c); In re Boe, 1992 Comm'r Pat. LEXIS 28, *71, *81. Here, the OED denied the Petitioner's reinstatement in its September 8, 1994, letter. The Petitioner contended that he did not receive that letter. Consequently, the OED re-sent the letter to the Petitioner on January 26, 1995. The Petitioner, however, did not seek review of the decision until 1998, well beyond the 30-day period prescribed in 37 C.F.R. § 10.2(c). The Petitioner's petition is therefore denied as untimely.

II. The Petitioner's Regrade Request

An applicant for registration to practice before the PTO in patent cases must achieve a passing grade of 70 in both the morning and afternoon sections of the registration examination. The morning section of the 1997 examination consisted of 50 multiple-choice questions, each worth two points. For each question, the OED instructed the test takers to select the most correct answer among five choices. The Petitioner received a score of 64 on the morning section. On request for regrade, the OED added two points to the Petitioner's score, raising it to 66. In

this petition, the Petitioner bears the burden of establishing error in the grading of his answers to examination questions 28, 34, and 49. See 37 C.F.R. § 10.7(c).

At the outset, the Petitioner argues that some of the questions on the morning section of the 1997 examination “are not multiple choice questions, as that term of art is know [sic], but are in fact multiple questions.” Specifically, the Petitioner contends that “[i]n an apparent effort to amplify the scope of the exam coverage beyond the stated 50 questions, OED has combined separate questions under a single entry.” Thus, the Petitioner contends that for each question that he answered properly, he should receive credit not only for selecting the most correct answer, but also for not selecting the other remaining four choices.

The Petitioner failed to raise that issue in his request to the OED for regrade, and instead improperly raises it for the first time in this petition. But even if the Petitioner had properly raised the issue before the OED, his arguments are unpersuasive. The questions in the morning section of the 1997 examination do not “combine[] separate questions under a single entry,” as the Petitioner asserts. Rather, the questions include a statement of facts, followed by an inquiry to the test taker. The answer choices present five options to the exam taker. The answer choices may include a conditional statement (e.g., “The interview will be granted if the applicant pays the appropriate fee.”). That form of answer choice does not pose an additional question, as the Petitioner contends. Rather, it simply seeks to test the depth and the breadth of the test taker’s knowledge of the relevant materials.

The Petitioner also makes separate arguments with respect to questions 28, 34, and 49. For the reasons explained below, however, he has failed to show any error in the OED’s regrading of those questions.

A. Question 28

Question 28 reads as follows:

28. Inventor Jones received a patent that, through error and without deceptive intent, failed to disclose an embodiment of the invention. Eighteen months later, Jones asks whether a reissue application may be filed. Jones also tells you that the original patent with the blue ribbon seal has been lost. Your advice to Jones should include:

- (A) under 35 U.S.C. § 251, new matter cannot be added to a reissue application.
- (B) any added claims to the new embodiment would not satisfy 35 U.S.C. § 112.
- (C) under 35 U.S.C. § 251, it is too late to enlarge the scope of the issued claims in a reissue application.
- (D) under 35 U.S.C. § 251, Jones cannot get a reissue of a patent that has been lost.
- (E) (A) and (B).

The most correct answer is (E). The question inquires which of four statements should be included in advice to inventor Jones who received a patent that, through error and without deceptive intent, failed to disclose an embodiment of the invention. Eighteen months later, Jones asks whether a reissue application may be filed. Jones also states that the original patent with the blue ribbon has been lost. Choice (A) is a correct statement because an applicant may not add new matter to a reissue application. See 35 U.S.C. § 251. Choice (B) is also correct. Any claims drawn to the new embodiment would not satisfy 35 U.S.C. § 112 because the facts specify that the new embodiment has not been disclosed. Thus, the application would fail to satisfy the written description requirement of the first paragraph of § 112. Choice (C) is incorrect because an applicant may file a broadening reissue within two years of the date the original patent issued, and here only 18 months have elapsed since the issuance of Jones's original patent. Choice (D) is also incorrect because the loss of the original patent does not automatically preclude the reissuance of the patent. See 37 C.F.R. § 1.178 (providing that, in lieu of the original patent, an

applicant may submit an affidavit attesting to the loss of the patent). Accordingly, the most correct answer is choice (E) because it includes choices (A) and (B).

The Petitioner selected answer choice (A). He argues that the OED instructed the test takers “not [to] assume any additional facts not presented in the questions,” and that answer choice (B) improperly “assumes the existence of ‘added claims.’” The Petitioner’s argument lacks merit. Answer choice (B) does not require the test taker to assume any additional facts. The question inquires about giving proper advice to Jones. The fact pattern states that the issued patent failed to disclose an embodiment of the invention. Answer choice (B) would properly advise Jones that “any added claims” to that embodiment would fail to satisfy the written description requirement of section 112 (emphasis added). Thus, the answer choice does not require the test taker to assume that Jones in fact seeks to add new claims, but rather states correctly that any such claims would not pass muster under section 112. Because both answer choices (A) and (B) are correct, (E) is the most correct answer choice because it includes both (A) and (B).

B. Question 34

Question 34 provides:

34. The following claims are included in a newly filed patent application:

Claim No.

1. Independent
2. Dependent on claim 1
3. Dependent on claim 1
4. Dependent on claims 2 and 3
5. Independent
6. Dependent on claim 1, 2, or 5
7. Dependent on claim 6

Which of the following represents the proper number of total claims for fee calculation purposes?

- (A) 10
- (B) 9
- (C) 11
- (D) 7
- (E) 8.

Claim 4 is an improper claim because it depends on multiple claims, yet fails to refer to them in the conjunctive, rather than in the alternative. See 35 U.S.C. § 112; 37 C.F.R. § 1.75(c). The claim is therefore not a proper multiple dependent claim. According to the Manual of Patent Examining Procedure (“MPEP”), an improper claim nonetheless counts as a single claim in calculating fees. See MPEP § 608.01(n) (1997). Furthermore, each independent claim counts as one claim for fee calculation purposes, whereas each multiple-dependent claim counts as the “number of claims to which direct reference is made therein.” 37 C.F.R. § 1.75(c). Thus, for fee calculation purposes, independent claims 1 and 5 count as one claim each, dependent claims 2 and 3 count as one claim each, improper claim 4 counts as one claim, multiple-dependent claim 6 and dependent claim 7 count as three claims each -- for a total of 11 claims. Answer choice (C) is therefore the most correct choice.

The Petitioner chose answer choice (A). He argues that 37 C.F.R. § 1.75 (“Rule 75”) and MPEP § 608.01(n) conflict with each other, but fails to state precisely why or how. Instead, he merely asserts that the OED improperly “elects the MPEP reading over the CFR requirements.” A comparison of Rule 75 and MPEP § 608.01(n), however, reveals no conflict. Rule 75 governs the proper format of independent, dependent, and multiple dependent claims. See 37 C.F.R. § 1.75. A proper multiple-dependent claim, Rule 75 instructs, must refer to the claims on which depends “in the alternative only.” Id. § 1.75(c). For fee calculation purposes, a proper multiple-

dependent claim “will be considered to be that number of claims to which direct reference is made therein.” Id.

Consistent with Rule 75, MPEP § 608.01(n) states that “a multiple dependent claim is a dependent claim which refers back in the alternative to more than one preceding independent or dependent claim.” MPEP § 608.01(n) (1997). Section 608.01(n) goes on to state that “[t]he fee for any improper multiple dependent claim . . . will only be one, since only an objection to the form of such a claim will normally be made.” Id. That rule, according to the MPEP, “greatly simplifies the calculation of fees.” Id. Thus, on their faces Rule 75 and MPEP § 608.01(n) are consistent with each other. The Petitioner has not articulated why MPEP § 608.01(n) and Rule 75 are inconsistent with one another and has therefore failed to show how the OED improperly relied on MPEP § 608.01(n).

C. Question 49

Question 49 states:

49. In response to a final rejection dated February 4, 1997, with a three month shortened statutory period for response, you call the examiner in charge of the patent application to schedule a first interview on July 3, 1997, to discuss further narrowing the scope of claim limitations. Your request for an interview should be _____

- (A) denied because your request is after the expiration of the shortened statutory period for response.
- (B) granted only if applicant pays the extension fee for the expired time.
- (C) granted.
- (D) denied because interviews are not permitted after the final Office action.
- (E) granted only if you have a proposed amendment and pay the extension fee.

The correct answer is choice (C). See MPEP §§ 706.07(f), 713.09. The Petitioner selected answer choice (B).

The MPEP clearly states: “Interviews may be conducted after the expiration of the shortened statutory period for response to a final office action but within the 6-month statutory period for response without the payment of an extension fee.” MPEP § 706.07(f)(13) (1997). Additionally, MPEP § 713.09 states “Normally, one interview after final rejection is permitted.” See id. § 713.09 (1997). That section further states that an interview may be held after the expiration of the shortened statutory period for response without an extension of time. Thus, answers (A), (B), (D), and (E) are all incorrect because they either state that interviews are not permitted after a final rejection, or after the shortened statutory period for response, or require payment of a fee to extend the time for a response -- all matters contradicted by the MPEP. Answer choice (C) is the best, and only, correct answer of the five possible answers presented. As the MPEP notes, one interview is normally granted after a final rejection.

The Petitioner argues that “the fact statement does not state whether a variable response period was set in accordance with MPEP 706.07(f)(2).” He therefore contends that “an extension and petition fee would be required under 37 C.F.R. § 1.136(a).” According to MPEP § 706.07(f), however, “All final rejections setting a three month shortened statutory period (SSP) for reply should contain one of [several specified] Form Paragraphs . . . advising applicant that if the response is filed within two (2) months of the date of the final Office action, the shortened statutory period will expire at three (3) months from the date of the final rejection or on the date the advisory action is mailed, whichever is later. Thus, a variable reply period will be established.” MPEP § 706.07(f) (1997). The fact pattern states that the final rejection has “a three month

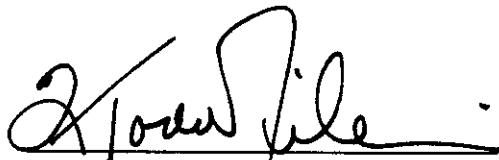
statutory period for response.” The final rejection would include an appropriate form paragraph and thus set up a variable reply period under MPEP § 706.07(f). The variable reply period is implicit in the final rejection with a three-month shortened statutory period under MPEP § 706.07(f). The Petitioner has therefore failed to show any grading error regarding question 49.

In view of the preceding discussion, the Petitioner is not entitled to credit for his answers to questions 28, 34, and 49.

ORDER

Upon consideration of the petition for reinstatement and for a higher score on the morning section of the 1997 examination, it is

ORDERED that the petition is denied.

A handwritten signature in black ink, appearing to read "Q. Todd Dickinson", is written over a horizontal line.

Q. Todd Dickinson
Acting Assistant Secretary of Commerce and
Acting Commissioner of Patents and Trademarks